

ESTTA Tracking number: **ESTTA1305063**Filing date: **08/21/2023**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers information

Name	Amer Sports Winter & Outdoor Company		
Entity	Corporation	Citizenship	Delaware
Address	2030 LINCOLN AVENUE OGDEN, UT 84401 UNITED STATES		

Name	Amer Sports Canada Inc.
Granted to date of previous extension	08/26/2023
Address	110-2220 DOLLARTON HWY. NORTH VANCOUVER, BC V7H1A8 CANADA
Party who filed extension of time to oppose	Amer Sports Canada Inc.
Relationship to party who filed extension of time to oppose	Amer Sports Canada Inc. is the name of the Canadian corporation filing this Notice of Opposition.

Attorney information	TERENCE P. O'BRIEN AMER SPORTS AMERICAS 130 EAST RANDOLPH STREET, SUITE 600 CHICAGO, IL 60601 UNITED STATES Primary email: terence.obrien@amersports.com Secondary email(s): ody@yang.law , elizabeth.lopez@amersports.com 7737146498
Docket no.	

Applicant information

Application no.	97407893	Publication date	06/27/2023
Opposition filing date	08/21/2023	Opposition period ends	08/26/2023
Applicant	adidas International Marketing B.V. ATLAS ARENA, AFRIKA BUILDING HOOGOORDDREEF 9A AMSTERDAM ZO, 1101BA NETHERLANDS		

Goods/services affected by opposition

Class 035. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Retail store services featuring clothing, footwear, headwear, bags and back packs; online retail store services featuring clothing, footwear, headwear, bags and back packs
--

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------

Mark cited by opposer as basis for opposition

U.S. registration no.	4563774	Application date	11/25/2013
Register	Principal		
Registration date	07/08/2014	Foreign priority date	NONE
Word mark	ARC'TERYX		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Dec 1, 2011 First Use In Commerce: Dec 1, 2011 Retail store services featuring rock climbing and mountaineering footwear, hiking footwear, ski footwear and backcountry ski boots, mountaineering and rock climbing equipment, bags, clothing and clothing accessories; online retail store services featuring rock climbing and mountaineering footwear, hiking footwear, ski footwear and backcountry ski boots, mountaineering and rock climbing equipment, bags, clothing and clothing accessories		

Attachments	97407893_TERREX_Notice_of_Opposition.pdf(2919911 bytes)
-------------	--

Signature	/Terence P. O'Brien/
Name	TERENCE P. O'BRIEN
Date	08/21/2023

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Amer Sports Canada Inc., and
Amer Sports Winter & Outdoor Company

Opposers,

v.

adidas International Marketing B. V.,

Applicant.

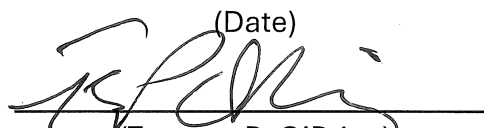
Opposition No. _____

Word Mark: TERREX
Serial No.: 97/407,893

I hereby certify that this correspondence
and all marked attachments are being
electronically filed with the Trademark Trial
and Appeal Board through their web site
located at <http://estta.uspto.gov> on

August 21, 2023

(Date)


(Terence P. O'Brien)

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Amer Sports Canada Inc., a Canadian corporation having a place of business at 110-2220 Dollarton Hwy., North Vancouver, British Columbia V7H 1A8, Canada, and Amer Sports Winter & Outdoor Company, a Delaware corporation having a place of business at 2030 Lincoln Avenue, Ogden, Utah 84401 (together, “Arc’teryx” or “Opposers”), will be damaged by registration of U.S. Serial Number 97/407,893 (the “Application-at-Issue”) filed by Applicant, adidas International Marketing B. V., (“adidas” or “Applicant”) on May 12, 2022, and published June 27, 2023. A description of the Application-at-Issue is as follows:

Mark: TERREX
Serial No.: 97/407,893
Applicant: adidas International Marketing B. V.
Filing Date: May 12, 2022
Filing Basis: 1(b)
Publication Date: June 27, 2023
International Class: 35
Goods: Retail store services featuring clothing, footwear, headwear, bags and back packs; online retail store services featuring clothing, footwear, headwear, bags and back packs

As grounds for this Opposition, Arc'teryx alleges:

1. adidas' Application-at-Issue, for the name TERREX in connection with International Class 35 for retail store services, should be denied registration because it is confusingly similar to the incontestable ARC'TERYX mark registered by Arc'teryx in connection with International Class 35.

2. The Application-at-Issue is likely to cause consumer confusion because the pronunciation of "TERREX" is identical to the pronunciation of the letters "TERYX" in ARC'TERYX. adidas intends to use the Application-at-Issue on the same services as Arc'teryx, namely retail store services within the meaning of International Class 35.

3. Consumers will likely confuse "TERREX" with "ARC'TERYX" if the Application-at-Issue is permitted to register.

4. There is already evidence of actual consumer confusion in a neighboring jurisdiction, Canada, where adidas has begun using the TERREX name in connection with retail store services. (See ¶¶33-39, below).

The Popularity of Opposers' ARC'TERYX brand

5. The ARC'TERYX brand has become popular and widely recognized while being in continuous use in the United States since at least 1991. The ARC'TERYX brand was first introduced in Vancouver, Canada in 1989, when it was used on technical apparel and related accessories and equipment for outdoor and recreational sports activities.

6. During this time, the ARC'TERYX brand became well-known for designing, marketing, and selling high-quality, innovative outdoor apparel and equipment, which it sells through its ARC'TERYX-branded retail stores, on its website www.arcteryx.com, and through third-party retailers.

7. As one example of the brand's popularity, *The Wall Street Journal* recently featured ARC'TERYX outdoor apparel, noting that "[t]he outdoor brand's Gore-Tex jackets have become a TikTok meme, thanks to their mesmerizingly waterproof fabric." (Jacob Gallagher, *Why Are All These People Showering in Their Arc'Teryx Jackets?*, *The Wall Street Journal*, Jan. 17, 2022).

8. Another widely circulated publication, *Women's Wear Daily*, referred to "Arc'teryx jackets [as] a status symbol among disparate social groups in New York City..." (Misty White Sidell, *EXCLUSIVE: Arc'teryx Opens Up About Growth Strategy, with U.S. Seen Key*, *Women's Wear Daily*, Mar. 21, 2023).

9. Amer Sports Winter & Outdoor Company is the exclusive operator of ARC'TERYX-branded retail store services throughout the United States. It currently operates approximately 28 ARC'TERYX-branded retail stores across the United States.

10. The ARC'TERYX-branded retail stores are community-hubs that equip guests with product knowledge and support them on their outdoor adventures.

The ARC'TERYX Registration and Opposers' Protectable Trademarks

11. Collectively, Amer Sports Canada Inc. and Amer Sport Winter & Outdoor Company are referred to as "Arc'teryx," or "Opposers," for purposes of this Notice of Opposition.

12. Amer Sports Canada Inc. is the owner of various registered trademarks and trademark applications directed to the word mark ARC'TERYX covering a variety of goods and services. Such registered trademarks include at least U.S. Trademark Reg. Nos. 2,136,908; 4,078,937; 4,563,774; and 5,407,641. Pending applications include at least U.S. Trademark App. No. 90/380,544; 97/784,588; and 97/213,616.

13. Generally speaking, these registered trademarks and pending applications are directed to use of the ARC'TERYX mark in connection with climbing and outdoor apparel, footwear for hiking and skiing, bags and accessories, as well as retail store and online services for selling such products directly to consumers.

14. This opposition proceeding is based upon the likelihood of confusion between the Application-at-Issue on one hand, and Amer Sports Canada Inc.'s U.S. Trademark Reg. No. 4,563,774 (the "ARC'TERYX Registration") and the associated common law rights in connection with International Class 35 on the other. A true and correct copy of the ARC'TERYX Registration is attached hereto as Exhibit [1] and made of record in this proceeding.

15. With respect to International Class 35, the ARC'TERYX Registration was first used in interstate commerce as early as December 1, 2011; was filed on November 25, 2013; and registered on July 8, 2014. The ARC'TERYX Registration has since achieved incontestable status within the meaning of the Lanham Act.

16. The ARC'TERYX Registration is directed to International Class 35 for "Retail store services featuring rock climbing and mountaineering footwear, hiking footwear, ski footwear and backcountry ski boots, mountaineering and rock climbing equipment, bags, clothing and clothing accessories; online retail store services featuring rock climbing and mountaineering footwear, hiking footwear, ski footwear and backcountry ski boots, mountaineering and rock climbing equipment, bags, clothing and clothing accessories."

17. Since at least 2011, Arc'teryx has continuously used and promoted, in interstate commerce, the word mark ARC'TERYX, covered by the ARC'TERYX Registration, in connection with retail store services, including approximately 28 retail stores nationwide, and the website www.arcteryx.com.

18. By virtue of such continuous and substantial use, the ARC'TERYX Registration has become a source identifier of the ARC'TERYX-branded retail store services and website operated and offered by Arc'teryx. As a result, Arc'teryx has built up, at great expense and effort, valuable goodwill in the ARC'TERYX Registration.

19. In addition to the ARC'TERYX Registration, Arc'teryx also owns common law rights in the ARC'TERYX mark used for retail store services. Arc'teryx acquired such common law rights (the "ARC'TERYX Cl. 35 Common Law Rights") at least as early as December 1, 2011, by virtue of its continuous use in connection with retail store services.

The ARC'TERYX Cl. 35 Common Law Rights have also become an identifier of ARC'TERYX-branded retail store services operated and offered by Arc'teryx.

20. Arc'teryx has invested substantial time and money in developing and promoting its retail store services under the ARC'TERYX Registration and the ARC'TERYX Cl. 35 Common Law Rights. As a result of the investments made by Arc'teryx, the consuming public has come to associate the ARC'TERYX Registration and the ARC'TERYX Cl. 35 Common Law Rights with Arc'teryx retail store services.

21. Arc'teryx has owned and used its International Class 35 ARC'TERYX Registration and the ARC'TERYX Cl. 35 Common Law Rights, which are valid and legally protectable trademarks, for retail services since at least as early as 2011. Registration of the Application-at-Issue would cause harm to Arc'teryx.

Adidas' Application-at-Issue in Class 35 for Retail Store Services Is Likely to Confuse Consumers in the United States

22. On or around May 12, 2022, adidas filed the Application-at-Issue directed to the word mark "TERREX" in connection with retail store services under International Class 35 before the United States Patent and Trademark Office.

23. The Application-at-Issue was filed on an intent-to-use basis pursuant to Section 1(b), 15 U.S.C. § 1051(b).

24. Upon information and belief, adidas is not currently offering retail store services under the TERREX name in the United States but intends to do so in the future. Registration and use of the Application-at-Issue by adidas would harm Arc'teryx, giving Arc'teryx a real interest, and thus standing, in this opposition proceeding.

25. Arc'teryx has priority over adidas' Application-at-Issue by virtue of its continuous use since at least December 1, 2011, for retail store services in International Class 35. Arc'teryx is the senior user relative to adidas.

26. At present, adidas has no United States trademark registrations directed to the name TERREX in conjunction with any kind of retail store services under International Class 35.

27. To the extent adidas has prior use or prior registration(s) of the TERREX name in connection with apparel under International Class 25, such prior use or prior registration(s) does not entitle adidas to expand into the retail store services of International Class 35.

28. Simply put, any alleged use of the TERREX name as an adidas sub-brand for goods in International Class 25 does not give adidas rights to a registration for use of the TERREX name as a mother brand (i.e., as a store nameplate) for retail store services in connection with International Class 35.

29. Class 25 and Class 35 constitute separate and independent rights and usages under trademark law and registrations.

30. adidas' expansion to retail services would lead consumers to become confused with the pre-existing ARC'TERYX retail outlets. Use of the ARC'TERYX mark in connection with retail store services is protected at least by the ARC'TERYX Registration and the ARC'TERYX Cl. 35 Common Law Rights.

31. Registration of the Application-at-Issue would lead to actual consumer confusion of directly competing store names, and would also create a likelihood of

consumer confusion when evaluated through the lens of the *DuPont* factors, or any other applicable legal test, for at least these reasons:

- a. The pronunciation of “TERREX” is identical to the pronunciation of the letters “TERYX” in ARC’TERYX. The marks are also similar in appearance.
- b. The Application-at-Issue is directed to the same, or substantially similar, services as the ARC’TERYX Registration and ARC’TERYX Cl. 35 Common Law Rights.
- c. adidas is intending to offer the same goods and services at its TERREX retail stores as Arc’teryx offers at its ARC’TERYX retail stores.
- d. adidas and Arc’teryx directly compete for the same or similar consumers.
- e. Consumers have already come to know, recognize, and seek out the ARC’TERYX mark.
- f. The conditions under which consumers shop at retail stores means they would be likely to enter a TERREX retail store, thinking it to be an ARC’TERYX retail store.
- g. Arc’teryx has the exclusive right to the ARC’TERYX Registration and does not permit third parties to use it.
- h. There is potential for widespread confusion in the United States.

32. Stated plainly, adidas is seeking to use a mark that is substantially similar to the ARC’TERYX mark, and to offer retail store services that are identical or substantially identical to the ARC’TERYX mark. If adidas the Application-at-Issue were permitted to register, it would create a substantial likelihood of confusion among consumers.

adidas' Use of the TERREX Name on a Canadian Retail Store Has Already Caused Confusion, Foretelling That Confusion Will Follow in the United States

33. Amer Sports Canada Inc. and adidas are currently engaged in civil litigation before the Supreme Court of British Columbia, No. S-231061. The litigation arises out of adidas' infringement of Amer Sports Canada Inc.'s International Class 35 Canadian registration for ARC'TERYX, due to adidas' launch of a new TERREX retail store in Vancouver. An application seeking an interlocutory injunction is pending.

34. adidas' activities in Canada have already caused consumer confusion, which will likewise follow in the United States if the Application-at-Issue were permitted to register. Arc'teryx will provide evidence of actual consumer confusion during the discovery and briefing phases of this opposition proceeding.¹

35. In Canada, adidas began using the TERREX name in connection with International Class 35 retail store services when it opened its own retail store in Vancouver, on or around December 24, 2022. Moreover, adidas opened its first TERREX retail store in Canada on the same block and four doors down from the ARC'TERYX retail store in Vancouver.

36. Within days of adidas opening the TERREX retail store, local media began publishing articles commenting on the confusion between the TERREX retail store and the ARC'TERYX retail store.

¹ Pursuant to TBMP 309.03(a)(2), Arc'teryx will provide its ample evidence of actual confusion in the Canadian case during the discovery phase rather than pleading it in this Complaint.

37. As one publicly available example, *Business in Vancouver* printed an article entitled “Terrex, Arc’teryx Battle it out on Vancouver’s West 4th Avenue,” which includes an interview given by Ms. Leslie Hawkins, Vice President of Retail for adidas.

38. In regard to that interview, the author noted: “While ***the Terrex and Arc’teryx store banners sound similar, and the names could be confusing***, Hawkins said she is not concerned about any lawsuits or court actions aimed at halting Adidas from using the Terrex name.” (Glen Korstrom, Terrex, Arc’teryx Battle it out on Vancouver’s West 4th Avenue, *Business Intelligence Vancouver*, January 20, 2023) (emphasis added).

39. Canada is a foreign jurisdiction, but actual consumer confusion in a similar market as the U.S. is predictive of likely confusion in the U.S. if the Application-at-Issue is allowed to register.

Adidas’ Application-at-Issue Should Be Denied Registration

40. Arc’teryx would be damaged by the registration of the Application-at-Issue due to its substantial similarity between the Application-at-Issue and its trademarks, and the likelihood of confusion that would follow.

41. The Application-at-Issue so resembles the ARC’TERYX Registration and the ARC’TERYX Cl. 35 Common Law Rights as to be likely to cause confusion, to cause mistake, or to deceive consumers in violation of Section 2(d) of the Lanham Act, codified at 15 U.S.C. § 1052(d) et seq.

42. Adidas already owns and uses its well-known adidas brand name on storefronts and its intention now to instead use a “Terrex” name on certain of its storefronts foretells the consumer confusion that would be exploited.

43. Arc'teryx has developed a fast-growing and exceptionally loyal consumer following for its brand and products in the retail store services Class 35, and is entitled to exclusive use of its trademarks, and the opposition of adidas' intention to be similar and confusing on storefronts.

44. Accordingly, Arc'teryx respectfully request that the present opposition be sustained and that registration of the Application-at-Issue, having serial no. 97407893 be refused.

Dated: August 21, 2023

Respectfully submitted,



Terence P. O'Brien
Amer Sports Americas
130 East Randolph Ave., Suite 600
Chicago, IL 60601
Telephone: 773-714-6498
Email: Terence.obrien@amersports.com

and

Oliver D Yang
Yang Law, LLC
311 South Wacker Drive, Suite 2470
Chicago, Illinois 60606
Telephone: 312-377-3234
Email: ody@yang.law

**ATTORNEYS FOR OPPOSERS, AMER SPORTS
CANADA INC., and AMER SPORTS WINTER &
OUTDOOR COMPANY.**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 21, 2023, the foregoing

NOTICE OF OPPOSITION

was served upon the following counsel of record via electronic transmission:

John Zaccaria
NOTARO, MICHALOS & ZACCARIA P.C.
100 DUTCH HILL ROAD, SUITE 240
ORANGEBURG, NEW YORK UNITED
STATES 10962

john.zaccaria@notaromichalos.com
trademark@notaromichalos.com
peter.bucci@notaromichalos.com

/Terence P. O'Brien/

***ATTORNEY FOR OPPOSERS, AMER SPORTS CANADA INC.,
and AMER SPORTS WINTER & OUTDOOR COMPANY.***

EXHIBIT 1

United States of America
United States Patent and Trademark Office

ARC'TERYX

Reg. No. 4,563,774

Registered July 8, 2014

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

ARC'TERYX EQUIPMENT INC. (CANADA CORPORATION)
100-2155 DOLLARTON HIGHWAY NORTH
VANCOUVER, CANADA V7H3B2

FOR: RETAIL STORE SERVICES FEATURING ROCK CLIMBING AND MOUNTAINEERING FOOTWEAR, HIKING FOOTWEAR, SKI FOOTWEAR AND BACKCOUNTRY SKI BOOTS, MOUNTAINEERING AND ROCK CLIMBING EQUIPMENT, BAGS, CLOTHING AND CLOTHING ACCESSORIES; ONLINE RETAIL STORE SERVICES FEATURING ROCK CLIMBING AND MOUNTAINEERING FOOTWEAR, HIKING FOOTWEAR, SKI FOOTWEAR AND BACKCOUNTRY SKI BOOTS, MOUNTAINEERING AND ROCK CLIMBING EQUIPMENT, BAGS, CLOTHING AND CLOTHING ACCESSORIES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-1-2011; IN COMMERCE 12-1-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,136,908 AND 4,078,937.

SER. NO. 86-128,068, FILED 11-25-2013.

DORITT L. CARROLL, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office